

## **REMARKS**

### **Status of the Claims**

The Office Action Summary indicates that claims 1-4, 7-10 and 22-25 are pending in the application of which claims 1-4, 7-10 and 22-32 are rejected. The body of the Office Action indicates that claims 1-3, 7-10, and 22-34 are pending. Applicants believe that claims 1-4, 7-10, and 22-34 are pending in this application.

Applicants originally filed claims 1-21 were subject to a restriction requirement mailed from the United States Patent and Trademark Office on July 31, 2000 and Applicants elected group I species I. Subsequent to the election of species, in an Office Action mailed from the United States Patent and Trademark Office on February 27, 2001, claims 1-11 were pending and claim 4 was withdrawn from consideration. In a response to Office Action mailed to the United States Patent and Trademark Office on May 29, 2001, Applicants cancelled claims 5, 6, and 11 without prejudice and added new claims 22-25 thus the claims pending after entry of the amendment were claims 1-3, 7-10, and 22-25. In a response to Office Action mailed to the United States Patent and Trademark Office on April 17, 2002, Applicants added new claims 26-34 thus after entry of the amendment the claims pending were claims 1-3, 7-10, and 22-34 with claim 4 being withdrawn from consideration.

Please cancel claims 1-3, 7-10 and 22-25 without prejudice to further prosecution in this or a related case.

### **Rejections of the Claims**

Claims 1-3, 7-8, and 26-32 currently stand rejected under 35 U.S.C. §102(e) over U.S. Patent No. 5,843,019 to Eggers et al. (hereinafter "Eggers"), claims 9-10 currently stand rejected under 35 U.S.C. §103(a) over Eggers, and claims 22-25 and 33-34 currently stand rejected under 35 U.S.C. §103(a) over Eggers in view of U.S. Patent No. 5,403,311 to Abele et al. (hereinafter "Abele"). Applicants respectfully request reconsideration of the rejections in light of the following remarks.

**CLAIM REJECTIONS UNDER 35 U.S.C. §102(e)**

Claims 1-3, 7-8, and 26-32 are rejected under 35 U.S.C. §102(e). Claims 1-3 and 7-8 are cancelled, thereby rendering the rejection of these claims moot. Independent claim 26 and claims 27-32 that depend therefrom currently stand rejected as anticipated by Eggers. Applicants respectfully traverse the rejection of these claims.

Independent claim 26 requires an insulative sheath surrounding a pair of arms along the long axis of each arm, the insulative sheath extending from the elongated body to the loop electrode. The loop electrode comprises a conductive material and has a pair of end sections and a curved base section. A ceramic coating is disposed over the entire length of each end section and each end section extends from an arm that is surrounded by an insulative sheath. The base section is free of the ceramic coating and energy applied to the electrode is focused at the base section.

A proper 35 U.S.C. §102(e) rejection requires that each and every element of the claim be taught by the reference. Eggers teaches “a resecting loop assembly 12” that has “an electrically conducting shaft 180’ covered with an outer electrically insulating layer 181 [and] [s]haft 180’ includes a *distal exposed portion 183* for completing the current return path with active electrode assembly 182” (col. 18, lines 50-54, FIG. 8B; emphasis added). Eggers teaches a distal exposed portion 183 that is located between the insulating layer 181 and the active electrode assembly 182. In contrast, Applicants claim a loop electrode having a ceramic coating disposed over the entire length of each end section which extend from an arm surrounded by an insulative sheath. All sections of Applicant’s claimed device, from the elongated body to the base section, are covered with either a ceramic coating or insulative sheath. Thus, Eggers could not possibly teach Applicant’s claimed invention at least because Egger’s teaches an exposed portion 183.

Moreover, in contrast to Applicants claimed invention, Applicants believe that Eggers teaches a portion of Eggers active electrode assembly 182, i.e., the distal exposed portion 183, has a beneficial effect in completing the current path. Accordingly, Applicant’s believe that Eggers’ electrode could not possibly focus energy at the base

section, as Applicant's claim, because at least some of the energy in Eggers active electrode assembly is lost in the "current return path" of distal exposed portion 183 (col. 18, lines 50-54). Therefore, Eggers does not disclose each and every element of Applicant's claim 26 and is an improper reference under U.S.C. §102(e). Claims 27-32 depend from claim 26 and are therefore patentable for at least all of the reasons for which claim 26 is patentable over Eggers.

Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3, 7-8 and 26-32 under 35 U.S.C. §102 (e).

#### **CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)**

Claims 9 and 10 are rejected under 35 U.S.C. §103(a) over Eggers. Claims 9 and 10 are cancelled, thereby rendering the rejection of these claims moot. Claims 22-25 and 33-34 are rejected under 35 U.S.C. §103(a) over Eggers in view of Abele. Claims 22-25 are canceled, thereby rendering the rejection of these claims moot.

Independent claim 33 and claim 34 that depends therefrom currently stand rejected as obvious over Eggers in view of Abele. Applicants respectfully traverse these rejections.

Independent claim 33 requires an insulative sheath surrounding a pair of arms along the long axis of each arm, the insulative sheath extending from the elongated body of the device to the loop electrode. The claimed loop electrode comprises a ceramic material and has a pair of end sections and a curved base section disposed between the end sections. A conductive coating is disposed on the base section, the end sections are free from conductive coating and energy applied to the electrode is focused at the curved base section.

Independent claim 33 and claim 34 that depends therefrom stand rejected as obvious under 35 U.S.C. §103(a) over Eggers in view of Abele. A proper 35 U.S.C.

§103(a) rejection requires there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Applicants believe that Eggers, described above, fails to teach or suggest an electrode where energy applied is focused at the base section. There simply is no suggestion in Eggers of the desirability of focusing energy anywhere in Egger's electrodes in particular, not at the base section as applicants claim. Eggers teaches an electrode where at least some of the energy is lost in the current return path of distal exposed portion 183. (col. 18, lines 50-54). Applicants believe that were one skilled in the art motivated to use Egger's electrodes, the intended function of Applicant's device to focus energy at the base section of the electrode would be detrimentally affected because the intended function of the exposed portion of Egger's electrodes is to complete "the current return path."

Applicants believe that Abele teaches a catheter "fabricated from a refractory material such as ceramic and [is entirely] coated with a conductive material, such as gold to provide a first electrode of the catheter." (col. 8, lines 59-64). Abele fails to cure the deficiencies of Eggers because Abele fails to teach or suggest an electrode where energy is focused at a base section of the loop electrode. Thus, neither Eggers, Abele or their combination teach or suggest or provide motivation for Applicant's claimed electrode that focuses energy at the base section. Accordingly, applicants submit that independent claim 33 and the claim that depends therefrom, claim 34, are patentable over Eggers in view of Abele.

Applicants respectfully request reconsideration and withdrawal of the rejections of claims 9-10, 22-25 and 33-34.

### **CONCLUSION**

In view of the foregoing, Applicants request withdrawal of all rejections and allowance of pending claims 26-34 in due course. The Examiner is invited to contact

Applicant's undersigned representative with any comments, questions, or any remaining issues.

Respectfully submitted,

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